

REMARKS

The Examiner has rejected claims 2-22 under 35 U.S.C. 102(e) as being anticipated by International Patent Application No. WO 01/01316 A2 to Evans et al. The Examiner has further rejected claims 3, 4, 14 and 15 under 35 U.S.C. 103(a) as being unpatentable over Evans et al. in view of U.S. Patent 5,502,766 to Boebert et al. In addition, the Examiner has rejected claims 7-10 and 17-20 under 35 U.S.C. 103(a) as being unpatentable over Evans et al. in view of U.S. Patent 5,034,980 to Kubota. Moreover, the Examiner has rejected claims 8, 9, 18 and 19 under 35 U.S.C. 103(a) as being unpatentable over Evans et al. in view of Kubota, and further in view of Boebert et al. Finally, the Examiner has rejected claims 10 and 20 under 35 U.S.C. 103(a) as being unpatentable over Evans et al. in view of Kubota, and further in view of U.S. Patent 4,281,216 to Hogg et al.

The Evans et al. reference discloses a system, method and article of manufacture for an electronic software distribution, post-download payment scheme with encryption capabilities, in which software is first at least partially encrypted ("damaged") (800) and is then distributed (e.g., made available for download by a user, 804, 806). A user is then able to submit payment (808), after which the user is provided with the appropriate decryption key (810).

The subject invention relates to protecting material after receipt of the material to be protected. In particular, the method and apparatus of the subject invention receives the material to be protected. Then, as claimed in claim 1, the material is damaged (e.g., enciphered), and the damaged version is stored. During the damaging process, the apparatus verifies the authorization of the material. Based on the results of the verification, the apparatus repairs the damaged version enabling rendering of the repaired/undamaged version of the material. In a further embodiment, the undamaged version of the material is allowed to be rendered (e.g., played back) during the verification process.

Applicant submits that Evans et al. neither discloses nor suggests distributing the software, damaging the received software, storing the damaged software pending verification of authorization, and repairing the damaged software after verification.

The Examiner indicates that Evans et al. discloses "means for receiving protected material", "means for generating a damaged version of said protected material", and "means for storing said damaged version of said protected material" at page 24, lines 25-30, in which "the clearinghouse receives, encrypts, and stores a master copy of the software" received from a publisher ("examiner considers the encrypted software as damaged content since without the decryption key is not usable; and wherein the generation of the damaged version of applicant's corresponds to encryption generation

of the software"). The Examiner further indicates that Evans et al. discloses "a verifier for determining an authorization to process said protected material" at Fig. 8, block 808 "where the verifier accept the payment and sending the decryption key for the protected material; examiner considers the accepting of the payment as determination of authorization and sending the decrypted key as authorization for processing the protected material". In addition, the Examiner indicates that Evans et al. discloses "means for repairing the damaged version of said protected material in response to said verifier determining the authorization" at page 5, lines 3-25.

As indicated in MPEP 2131, it is well-established that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In addition, "The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Applicant submits that while Evans et al. discloses each of the above elements, they are not arranged as set forth in, for example, claim 22, but rather, are part of a system which includes several apparatuses, e.g., the clearinghouse (discussed but not

shown in Evans et al.) as well as the end user's (508) computer system as shown in Fig. 4. As such, while the clearinghouse includes "input means for receiving material in an unprotected form from a remote source", "means for generating a damaged version of said received material", "means for storing said damaged version of said received material", and "a verifier for determining an authorization to process said received material", the clearinghouse does not include "means for repairing the damaged version of said received material in response to said verifier determining the authorization". Correspondingly, while the end user's computer includes "means for storing said damaged version of said received material", "a verifier for determining an authorization to process said received material", and "means for repairing the damaged version of said received material in response to said verifier determining the authorization", the end user's computer does not include "input means for receiving material in an unprotected form from a remote source" and "means for generating a damaged version of said received material".

Applicant submits that the invention, as claimed in claim 22, is "An apparatus for receiving, protecting and storing material, said apparatus comprising...", and not "a plurality of apparatuses which collectively comprise...."

The Boebert et al. patent discloses a data enclave and trusted path system in which data is "damaged" prior to being

stored on removable media. However, Applicant submits that Boebert et al. does not supply that which is missing from Evans et al., i.e., distributing the software "in an unprotected form", wherein a single apparatus receives the software in an unprotected form, damages the received software, and then stores the damaged software pending verification of authorization, whereupon the single apparatus repairs the damaged software. In fact, it appears that all data with respect to Boebert et al. is enciphered prior to any transmission or storage.

The Kubota patent discloses a microprocessor for providing copy protection, in which "A given digital data is exclusively OR'ed with a given encryption code to provide an encrypted output. Further if this encrypted output is again exclusively OR'ed with the same encryption code, the original input is obtained." (col. 4, lines 46-52).

However, Applicant submits that the Kubota patent does not supply that which is missing from Evans et al., i.e., distributing the software "in an unprotected form", wherein a single apparatus receives the software in an unprotected form, damages the received software, and then stores the damaged software pending verification of authorization, whereupon the single apparatus repairs the damaged software.

The Hogg et al. patent discloses key management for encryption/decryption systems in which a key word is destroyed

"responsive to an unauthorized attempt to read said at least one key word" or, alternatively, "responsive to said at least one key word being transferred from said keyloading means to a predetermined number of the security modules." (col. 12, lines 27-40).

However, Applicant submits that Hogg et al. does not supply that which is missing from Evans et al. and/or Kubota, i.e., distributing the software "in an unprotected form", wherein a single apparatus receives the software in an unprotected form, damages the received software, and then stores the damaged software pending verification of authorization, whereupon the single apparatus repairs the damaged software.

In view of the above, Applicant believes that the subject invention, as claimed, is neither anticipated nor rendered obvious by the prior art, either individually or collectively, and as such, is patentable thereover

Applicant believes that this application, containing claims 2-22, is now in condition for allowance and such action is respectfully requested.

Respectfully submitted,

by   
Edward W. Goodman, Reg. 28,613  
Attorney  
Tel.: 914-333-9611